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EXAMINER

FOSTER, ROLAND G

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 02/11/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

2

Office Action Summary

Application No.

09/374,408

Applicant(s)

ANDREWS, CHRISTOPHER C.

Examiner

Roland G. Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Response to Arguments

On pages 2 and 3 of the response, filed on November 24, 2003 as Paper No. 24 (the "response"), the applicant argues with respect to the examiner's objection to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the applicant cites portions of the specification and then argues that these same sections provide the proper antecedent basis for all three terms: "independently accessible address", "separately and directly accessible", and "unique to the recorded audio file."

Although the applicant's arguments have been duly considered, they are not deemed fully persuasive.

The use of a confusing variety of terms for the same thing should not be permitted.

....

While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, Ex parte Kotler, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 901).

MPEP § 601.01(o). See also 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01 (emphasis added).

Here, the applicant has argued that a variety of terms are used to describe the same parts of the specification (same thing). Therefore, the applicant should make the appropriate

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amendment to the specification in order to insure certainty in construing the claims in light of the specification.

On page 4 of the response, the applicant argues with respect to the Choksi (U.S. Patent No. 6,477,243 B1) that:

When Choksi describes the [voice] message reception station...it is only in the context of notifying the sender that the message has been successfully received and/or reviewed.

....

Choksi does not teach that...the voice message is handled any different than the traditional reception and processing of voice messages.

Although the applicant's arguments have been duly considered, they are not deemed fully persuasive. Despite applicant's arguments otherwise, there is little difference in context between the main embodiment (facsimile message reception station) and alternate embodiments (voice message reception station). For example, the context of providing notification that the message was successfully received at a message reception station in the alternate embodiment is also same context that the facsimile message reception station is used in the main embodiment contrary to applicant's arguments. Specifically, Choksi teaches in the main embodiment that the facsimile message reception station also notifies the sender that the message has been successfully received (abstract). The notification is an e-mail that includes the independently accessible address as consistent with the applicant's specification and as discussed in the prior Office action.

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In addition to the similarity of contexts between main embodiment and alternate embodiments as discussed above, Choksi also provides clear and express motivation to include the teachings from the main embodiments (including the e-mail notice comprising the independently accessible address) in the alternate embodiments. For example, Choksi concentrates on an automated facsimile message system in the main embodiment but then states "the present invention should in no way be limited thereby" and that "in addition to the above-describe embodiments, a...voice...system configured in accordance with the present invention may include a message reception station configured to received voice...messages...and to notify each sender therefor of the successful receipt...of a message (col. 9, lines 30-41) (emphasis added) (i.e., via e-mail notification as done in the facsimile system, main embodiment).

The applicant then provides a series of general, conclusory statements some of which are repeated throughout pages 4-13. For example, after providing specific arguments as discussed above, the applicant then introduces a distinct conclusion that "[f]urther, Choksi does not teach or make obvious any notification of the recipient of a received voice message." Then the applicant immediately introduces another distinct conclusion that "[s]till further, Choksi does not teach or make obvious that the voice messages are each separately and directly accessible at an independently accessible address, that is unique to the voice message" (page 4, paragraph 2). The applicant then goes on to introduce a series of five consecutive and distinct conclusions in the third paragraph (page 4).

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The applicant's various conclusions as discussed above are not deemed persuasive. First, the conclusions do not seem to follow from the specific applicant arguments discussed and rebutted above. Second, even though the applicant broadly discusses the applicant's specification (e.g., pages 2-3 and 4-5), the subject claims (e.g., pages 5 and 6), and the teachings of Choksi (e.g., page 3), the applicant still fails to provide reasons that specifically support the applicant's series of conclusory statements.

The reply by the applicant...must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.

....

A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

Patent Rule 37 CFR 1.111(b) (emphasis added)

Here, the applicant has failed to provide specific arguments that point out the distinctions believed to render the claims patentable but instead offers a series of unsupported and general conclusions that amount to general allegations as discussed above. Thus, applicant's arguments fail to comply with 37 CFR.111(b). It is a fundamental concept in administrative law that proper notice (e.g., notice to both the public and to the Office concerning the supposed errors in the examiner's Office action) should include specific and clear arguments that support the applicant's general conclusions.

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On page 14 of the response, the applicant argues with respect to Bobo (U.S. Patent No. 5,675,507) that:

Bobo does not teach that a message is directly accessible using an independently accessible address. To access a message in the system of Bobo, a user must first log into their mailbox, select the appropriate anchor and then select the message. Within the system of Bobo, a user cannot directly access a message without going through their mailbox

Although the applicant's arguments have been duly considered, they are not deemed persuasive. The applicant is mixing the concepts of accessibility and security despite the fact that the applicant's own specification maintains such a distinction. Specifically, in the background section of the applicant's specification, the applicant teaches of a distinct security concept, where just as in Bobo, the applicant must log into an Internet site (i.e., security) before actually accessing the data not only at the Internet site but at other sites on the Internet as well (i.e., accessibility) (page 2, lines 16-25). The applicant's invention is then directed to providing increased accessibility (e.g., pages 3-7) but never discloses that the elimination of security (e.g., logins) as disclosed in the background section as a means to improve accessibility over the prior art. Therefore, applicant's specification consistently maintains a distinction between security and accessibility.

Similarly to the applicant's specification, Bobo also maintains a distinction between security and accessibility. For example, the URL associated with the recorded audio file "can be retrieved at the user's convenience at any time by connecting to the Internet....at virtually any location in the world" (Bobo, col. 18, lines 37-44). A URL (address) that is accessible via the WWW at any location in the word can certainly be considered an independently accessible

address. Just because the user may have to provide a logon ID or password in order to access the address makes it no less independently accessible. For example, a first and second user who do not know each other share the corporate mailbox and thus have the same password. However, the first user accesses the URL using a web-enabled cellular telephone in Europe while the second user accesses the same URL five days later using a personal computer in Asia. By any normal sense, the users have just independently accessed the URL even though they had to provide a password for the purposes of mailbox security.

The applicant also states various conclusory statements regarding the teachings of Bobo but these are unpersuasive for the same reasons that the conclusory statements regarding the teachings of Choksi were unpersuasive as discussed above

The applicant argues on pages 14 and 15 with respect to Acharya (U.S. Patent No. 6,408,296 B1) that Acharya does not teach that each hyperlink points to an address unique to the recorded audio file and that the combination is improper.

Although the applicant's arguments have been duly considered, they are not deemed persuasive. The applicant appears to support the above conclusions by referring to the actual invention disclosed in Acharya. However, the Office action make clear that the examiner only relied upon Acharya's teachings as disclosed in the background of the invention. Therefore, the applicant's arguments regarding the actual invention taught by Acharya are irrelevant.

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The applicant also states various conclusory statements regarding the teachings of Acharya and Uppaluru (U.S. Patent No. 5,915,001) but these are unpersuasive for the same reasons that the conclusory statements regarding the teachings of Choksi were unpersuasive as discussed above.

For the above reasons, the applicant's arguments are not deemed persuasive and the following rejections are repeated.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "independently accessible address", "separately and directly accessible", and "unique to the recorded audio file."

Claim Rejections Using Choksi as a Base Reference

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-9 and 12-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,477,243 B1 to Choksi et al. ("Choksi"), as used in the prior Office action.

With respect to claim 1, the following paragraphs for additional details on how Choksi discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a...[fax] recording device" reads on Figs. 1 and 6 where the transmitting fax 12 establishes a telephony connection via PSTN 16 in order to establish a connection with computer 18 (fax recording device). See also col. 5, lines 5-12.

The limitation "b. recording...[a fax] communication transmitted over the telephony connection thereby establishing a recorded...[fax] file" reads on Fig. 6, steps 106 and 108 where the transmitted fax is received and stored on computer 18.

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The limitation "c. associating an independently accessible address with the recorded...[fax] file, such that when the address is accessed using the computer system, the recorded...[fax] file is transmitted to the computer system for playback" reads on Choksi as follows. Upon receipt of the fax, an e-mail including the URL of a web page at which the stored fax message may be sent to the user (col. 8, lines 49-56). The user then may access the fax message by visiting the web page associated with the URL within the e-mail (col. 8, lines 56-67) which is consistent with the applicant's specification.¹ The phrase "independently accessible address" is extremely broad. For example, the URL (address) associated with the recorded fax file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded...[fax] file is separately and directly accessible using the independently accessible address" reads on Fig. 1 where the recorded fax is stored at a URL (as discussed above) accessible via the Internet 22 at virtually any location in the world. An URL (address) that is accessible via the Internet at virtually any location in the world can be considered a separately and independently accessible address. For example, an "independent" computer 24 is capable of "separately" "accessing" the recorded fax file somewhere else on the Internet. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the URL within the e-mail which is consistent with the applicant's specification as discussed above.²

¹ This interpretation is consistent with the applicant's specification, which states that an e-mail containing the address of the message is sent to the user (page 8, lines 17-22, and page 13, lines 8-10).

The limitation "wherein the independently accessible address is unique to the recorded...[fax] file" reads on col. 7, line 65 – col. 8, line 2, col. 8, lines 53-55, and col. 10, lines 23-28 where the address "specifies" the location (web page) of the fax file via a URL address within a remote e-mail message. Therefore, the address is unique to the file otherwise it would not be able to specify (i.e., specific to) the location of the fax file via a remote e-mail.

Although Choksi discloses the processing of a recorded fax in the main embodiment as discussed above, Choksi fails to disclose in the main embodiment the recorded audio files are processed in the same manner. However, Choksi teaches in another embodiment that, in addition to processing fax files as discussed above, the system also processes voice messages (recorded audio files) (col. 9, lines 30-45).³

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the second embodiment supporting recorded audio files as taught by Choksi to the first embodiment disclosed by Choksi.

² Note that the applicant's specification fails to provide antecedent basis for the terms "separately and directly accessible", "independently accessible address", and "unique to the recorded file" as discussed above. Nonetheless, examiner's interpretation is reasonably broad consistent with the applicant's specification.

³ Note that there is little difference in context between the main embodiment (facsimile message reception station) and alternate embodiments (voice message reception station). For example, the context of providing notification that the message was successfully received that a message reception station in the alternate embodiment is also same context that the facsimile message reception station is used in the main embodiment contrary to applicant's arguments. Specifically, Choksi teaches in the main embodiment that the facsimile message reception station also notifies the sender that the message has been successfully received (abstract). The notification is an e-mail that includes the independently accessible address as consistent with the applicant's specification and as discussed in footnote 1.

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The suggestion/motivation for doing so would have been that Choksi teaches that the "present invention should in no way be limited" to the main embodiment but instead additionally support recorded audio files (col. 9, lines 30-45).⁴ In addition, it would have been facially obvious to one of ordinary skill in the art, upon inspecting single patent containing two embodiments, to have incorporated compatible features from one embodiment into the other embodiment because both embodiments are disclosed in the same document to the person of ordinary skill.

Claim 12 differs substantively from claim 1 in the following addition limitation "notification is sent to a recording user responsible for recording the audio communication, the notification specifying..." which reads on the transmittal of the e-mail containing the URL to the recording user as discussed in the claim 1 rejection above.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on the transmittal of e-mail message (second file) which includes the file (col. 8, lines 40-58) modified to include the audio file (see the claim 1 rejection).

⁴ Specifically, Choksi concentrates on an automated facsimile message system in the main embodiment but then states "the present invention should in no way be limited thereby" and that "in addition to the above-described embodiments, a...voice...system configured in accordance with the present invention may include a message reception station configured to received voice...messages...and to notify each sender therefor of the successful receipt...of a message (col. 9, lines 30-41) (emphasis added) (i.e., via e-mail notification as done in the facsimile system, main embodiment).

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Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection..." reads on Fig. 1, telephone 29. The limitation "b. means for recording..." and "c. means for storing..." reads on Fig. 1, computer 18.

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. See also Figs. 1 and 5 which illustrate the various circuits and systems to perform the functions recited in the claim. See the claim 22 rejection for further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. Further, the limitations "a. a call processing and recording system" reads on Fig. 5, fax message 44 and "b. a server coupled to the call processing and recording system" reads on Fig. 5, e-mail notification server 50. The limitation "c. one or more computer systems" reads on Figs. 1 and 5. Note that the above components have been modified to support recorded audio files (see the claim 1 rejection).

With respect to claim 44-47, see the claims 1, 22, 30, and 37 rejections respectively plus the claim 12 rejection for further details.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Bobo where the message is played back to each of the one or more users who uses the URL to received the recorded audio file.

With respect to claims 2 and 18, see Fig. 5.

With respect to claims 3, 8, and 20, see col. 8, lines 60-67. Entry of a PIN would require a user profile to recognize the PIN.

With respect to claims 4, 5, 9, 13, 33, and 42, see the claims 1 and 37 rejections for further details.

With respect to claims 6, 29, 36, and 43, although Choksi discloses sending the URL in the e-mail as discussed above, Choksi fails to disclose that the e-mail is in the form of a hyperlink.

However, "Official Notice" was taken in the last Office action that both the concept and advantages of including hyperlinks in e-mail would have been well known and expected in the art. The applicant's lack of traverse to the officially noticed fact in the last Office action (i.e., the response) is taken as an admission of the facts noticed.

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a hyperlink to the e-mail comprising the URL as disclosed by Choksi.

The suggestion/motivation for doing so would have been to integrate the e-mail system with browsing capability and thus increase user-friendliness, efficiency and flexibility so that the user can directly launch a browser for the address corresponding to a particular URL address (i.e., eliminate browser launching and address selection steps) by simply clicking on a hyperlink within the e-mail as is notoriously well-known in the art.

With respect to claims 7, 18, 19, 23-28, 32, 34, 35, and 39-41, see Fig. 1.

With respect to claim 14, the link (URL) is posted in the e-mail (predetermined location).

With respect to claim 15, see col. 8, lines 60-67.

With respect to claim 16, although Choksi discloses that the user is provided descriptive information regarding the message (col. 8, lines 49-67), Choksi fails to specifically disclose that this information include the title.

However, "Official Notice was taken in the last Office action that both the concept and advantages of including the "title" in descriptive information about a file would have been well-

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known and expected in the art. The applicant's lack of traverse to the officially noticed fact in the last Office action (i.e., the response) is taken as an admission of the facts noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add "title" to the descriptive file information disclosed by Choksi.

The suggestion/motivation for doing so would have been to quickly convey salient and easily remembered information about the file such as title as is notoriously well known in the art.

With respect to claim 21, see the claim 12 rejection above.

With respect to claims 31 and 38, see Fig. 5, archive 48.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choksi as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 5,809,512 to Kato ("Kato"), as used in the last Office action.

Choksi fails to disclose that the user or a location profile specifies a time where the recorded file is available for playback after a delay period.

However, Kato (similarly to Choksi) teaches of a multimedia message storage system (abstract) where the user specifies a delay period for posting (available for playback) using a

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stored, predetermined schedule (location profile) or manually (col. 75, lines 13-25, col. 76, lines 7-52, and col. 77, lines 1-5).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made the add the ability for the user to specify a delay using location profile or manually as taught by the message storage system of Kato to the message storage system of Choksi.

The suggestion/motivation with respect to a location profile would have been to increase the flexibility, versatility and efficiency and to reduce the cost of the message storage system by allowing the user to individually determine time periods in accordance with utilization conditions, CPU performance capabilities, and cost (Kato, col. 76, lines 18-52). In addition, flexibility would have been increased by allowing the user to determine posting time such as when the user has an urgent need to post the message immediately.

Claim Rejections Using Bobo as a Base Reference

Claim Rejections - 35 USC § 103

Claims 1-7, 9, 13-19, 22-43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,675,507 to Bobo, II ("Bobo"), as used in the last Office action, in view of U.S. Patent No. 6,408,296 B1 to Acharya et al. ("Acharya"), as used in the last Office action.

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With respect to claim 1, the following paragraphs for additional details on how Bobo discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a call recording device" reads on Figs. 1 and 2, where a telephone call (telephony connection) is established between Telephone Set 26 (telephony device) and a call recording device (Message Storage and Delivery System) (MSDS 10).

The limitation "b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file" reads on Fig. 2, step 52 where the voice message is recorded and stored.

The limitation "c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio file is transmitted to the computer system for playback" reads on Bobo as follows. The user accesses the voice message (recorded audio file) on the computer system by selecting the anchor (col. 13, lines 5-33). The anchor (hyper-text link) points to address where the file (e.g., voice message) is stored (e.g., <A HREF=1.wav") (col. 8, lines 8-20, col. 12, lines 30-54, and col. 13, lines 1-33). Therefore, the address is accessed using the computer system when the user selects the anchor (hypertext link) which points to the address of the recorded file consistent with the

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applicant's specification.⁵ The phrase "independently accessible address" is extremely broad.

For example, the URL (address) associated with the recorded audio file is an address

independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded audio file is separately and directly accessible using the independently accessible address" reads on col. 18, lines 35-56 where the recorded audio file is accessible via the WWW at "virtually any location in the world". An URL (address) that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, an "independent" computer is capable of "separately" "accessing" the recorded audio file somewhere else on the WWW. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the anchor (hyperlink) consistent with the applicant's specification as discussed above.⁶

Although Bobo discloses that the address is independently accessible as discussed above, Bobo fails to specifically disclose that the address is "unique to the recorded audio file."

However, Bobo teaches that the hyperlink points to as address as discussed above. The address represents the location of the file on a computer connected to the Internet. If the address was not unique to the file, then the user would have difficulty locating and retrieving the file after selecting the hyperlink. Further, a web hyperlink allows the user to expressly spell out the

⁵ This interpretation is consistent with the applicant's specification, which states that the user accesses the address where the recorded file is stored by "selecting a hyperlink pointing to the address" (page 4, lines 14-16, page 8, lines 17-22, and page 13, lines 12-14).

⁶ See footnote 2.

full path of the recorded file. That is, the user can specify the content of the hyperlink without structural modification to reflect the full path (address) unique to the recorded file. Therefore, Bobo strongly suggests that the content of the hyperlink (address) would have been unique to the file in order to successfully locate and retrieve the file.

Nonetheless, Acharya teaches of a web system where a "each traditional hyperlink is associated with a single URL, each hyperlink is associated with a single file having a particular location on a particular server" (i.e., the address) (col. 1, lines 35-47). Therefore, Acharya teaches that each hyperlink points to an address unique to the recorded audio file.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability of the hyperlink to point to an address unique to the recorded audio file as taught by the web access system of Acharya to the web access system of Bobo where the hyperlink points to an address of the recorded file.

The suggestion/motivation for doing so would have been to increase the efficiency and reliability of recorded file retrieval. Specifically, if the hyperlink did not point to an address unique to the recorded file, then the system of Bobo would have had difficulties reliably locating and retrieving the recorded file. Further, the prior art recognizes that it is "traditional" for a hyperlink to point an address unique to a file (Acharya, col. 1, lines 44-50). Finally, Bobo provides the capability (no structural modification required) for the user to specify the content of the hyperlink to reflect the full path (address) unique to the recorded file as discussed above. A

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recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). In this way, owners of the patented prior art devices are protected when using their devices as they see fit. Here, the content of the prior art hyperlink structure of Bobo is able to perform the intended use of identifying a unique address for the file as discussed above. Therefore, Bobo as modified meets the claim requirements.

Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on Bobo as discussed above where the recorded file is included in a second file such as "1.wav" that is accessed via an html file containing the anchor (hyperlink) (first file).⁷ See the claim 1 rejection for additional details.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection..." reads on Fig. 1, Telephone Set 26. "[B]. Means for recording...." and "c. means for storing..." reads on Fig. 1, MSDS (10).

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. Further, the limitations "a. a call processing and recording system" reads on Fig. 13, Central Processor (3) and "b. a server coupled to the call processing and recording system" reads on Fig. 13, Internet Server 5. Note that Fig. 13 illustrates the various systems that comprise MSDS 10. See also col. 16, lines 47 – 67. The limitation "c. one or more computer systems" reads on Fig. 1, Computer 32.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Bobo where the message is played back to each of the one or more use who logs into the mailbox with the appropriate ID and password.

With respect to claim 2, see Fig. 13, Internet Server 5 and col. 17, lines 37-43.

⁷ Note that is interpretation is also consistent with the applicant's specification which also indicates that including the audio file within a second file such as a web page or e-mail may be accomplished by including a hypertext link (anchor) to a recorded file (Fig. 6, step 152 and page 16, lines 24-28).

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With respect to claim 3, see Fig. 8 and col. 12, line 63 – col. 13, line 23. Note that the address (URL) is accessed when the audio file is retrieved.

With respect to claims 4, 28, and 42, see col. 13, lines 10-15 where the user selects an anchor (hyperlink) to access a voice message (audio file). Although the anchor (hyperlink) may be a simple HREF command referring to the voice message (audio file), selecting the hyperlink would still result in the html address (URL) corresponding to user's mailbox on the Internet Server 5 being sent to Internet Server 5 in order for the browser to request and retrieve the voice message (audio file) from Internet Server 5.

With respect to claims 5, 25, 26, 33, and 34, see Fig. 1 where an Internet (data) connection is established between the Computer 32 and the MSDS 10 in order to play back recorded audio (col. 12, line 63 – col. 13, line 33).

With respect to claims 6, 29, 36, and 43, see col. 13, lines 10-15 and the claim 4 rejection above.

With respect to claims 7, 24, 32, and 39, see Fig. 13 where the Internet Server 5 (server) is remote from the Computer 32 (computing system).

With respect to claim 9, the message storage process of Fig. 2 and message retrieval process of Fig. 3 are separated by time. The phrase "recorded audio file is first available for

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playback" is a broad term. For example, an audio file may be only considered "available" to the user when the user has established an Internet connection and successfully logged onto the MSDS 10 by entering a correct logon id and password. If the user is unable to log onto the MSDS 10, then the audio files are "unavailable" to the user.

With respect to claim 13, see col. 8, lines 10-20 and col. 13, lines 16-18.

With respect to claim 14, the link is posted in a predetermined location, namely in the MSDS 10.

With respect to claim 15, see col. 13, lines 13-14.

With respect to claim 16, see Table 1 (col. 12, lines 30-53).

With respect to claim 18, the web server would serve the html file and anchored audio file (step of including is performed by a server).

With respect to claim 19, see Fig. 13 where the Internet Server 5 (server) is remote from the Computer 32 (computing system).

With respect to claims 23, 31, and 38, see Fig. 15, Storage (11).

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With respect to claim 27, see Fig. 13, Internet Server (5).

With respect to claim 35, see Fig. 15, Storage (11) where the html files are addressed via the Internet (30).

With respect to claim 40, see col. 6, lines 20-22.

With respect to claim 41, see Fig. 1.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo in view of Acharya as applied to claims 1 and 9 above, and further in view of Kato.

Bobo fails to disclose the limitations within claims 10 and 11 however this would have been an obvious addition as taught by Kato. See the Choksi in view of Kato rejection above for further details regarding the obviousness of adding the teachings of Kato.

Claim Rejections Using Uppaluru as a Base Reference

Claim Rejections - 35 USC § 102

Claims 1, 8, 17, 20, 22, 30, 37, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent NO. 5,915,001 to Uppaluru ("Uppaluru"), as used in the last Office action, in view of Acharya.

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Uppaluru teaches of a system for providing speech files that are accessible via the Internet. Significantly, Uppaluru also teaches of allowing users to make the speech files accessible (publishing the speech files) using a telephonic connection.

With respect to claim 1, the following paragraphs for additional details on how Uppaluru discloses particular limitations in the claim.

The limitation "a. establishing a telephony connection between a telephony device and a call recording device" reads on col. 20, lines 4-10.

The limitation "b. recording an audio communication transmitted over the telephony connection thereby establishing a recorded audio file" reads on col. 21, lines 10-13.

The limitation "c. associating an independently accessible address with the recorded audio file, such that when the address is accessed using the computer system, the recorded audio file is transmitted to the computer system for playback" reads on Uppaluru as follows. A URL (address) is associated with the recorded audio files (col. 21, lines 25-29 and col. 7, lines 13-67). The URL can then be accessed telephonically (col. 7, lines 28-39) or via a WWW browser (col. 7, lines 20-21) via hyperlinks (abstract). The hypertext link points to address where the file (e.g., voice message) is stored (e.g., <A HREF="myweb/home/prompts.vml#prompt1") (Appendix A). Therefore, the address is accessed using the computer system when the user selects the hypertext

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link which points to the address of the recorded file.⁸ The phrase "independently accessible address" is extremely broad. For example, the URL address of Uppaluru associated with the recorded audio file is an address independently accessible by any computer browser connected to the WWW.

The limitation "wherein the recorded audio file is separately and directly accessible using the independently accessible address" reads on Uppaluru as follows. The recorded audio file is accessible via the WWW using a conventional web browser (col. 7, lines 20-23) which means the file is accessible at virtually any location in the world. An address that is accessible via the WWW at virtually any location in the world can be considered a separately and independently accessible address. For example, an independent computer is capable of "separately" "accessing" the recorded audio file somewhere else on the WWW. As for being "directly" accessible, the user "directly" accesses the recorded file by selecting the anchor (hyperlink) (abstract) consistent with the applicant's specification as discussed above.⁹

Although Uppaluru discloses that the address is independently accessible as discussed above, Uppaluru fails to specifically disclose that the address is "unique to the recorded audio file."

However, Uppaluru teaches that the hyperlink points to as address which certainly appears unique to the file as discussed above. The address represents the location of the file on a

⁸ See footnote 5.

⁹ See footnote 2.

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computer connected to the Internet. If the address was not unique to the file, then the user would have difficulty locating and retrieving the file after selecting the hyperlink. Further, a web hyperlink allows the user to expressly spell out the full path of the recorded file. That is, the user can specify the content of the hyperlink without structural modification to reflect the full path (address) unique to the recorded file. Therefore, Uppaluru strongly suggests that the content of the hyperlink (address) would have been unique to the file in order to successfully locate and retrieve the file.

Nonetheless, Acharya teaches of a web system where a "each traditional hyperlink is associated with a single URL, each hyperlink is associated with a single file having a particular location on a particular server" (i.e., the address (col. 1, lines 35-47). Therefore, Acharya teaches that each hyperlink points to an address unique to the recorded audio file.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the ability of the hyperlink to point to an address unique to the recorded audio file as taught by the web access system of Uppaluru to the web access system of Bobo where the hyperlink points to an address of the recorded file.

The suggestion/motivation for doing so would have been for the same reasons that Acharya was an obvious addition to Bobo. Therefore, see the claim 1, Bobo in view of Acharya rejection for further details.

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Claim 17 differs substantively from claim 1 in the following limitation. The limitation "c. including the recorded audio file within a second file, such that when the second file is accessed using the computer system, the recorded audio file is available for playback at the computer system" reads on Uppaluru as discussed above where the recorded file is included in a second file such as "prompt.vml" that is accessed via an html file containing the anchor (hyperlink) (first file).⁵ See the claim 1 rejection for additional details.

Claim 22 differs substantively from claim 1 in that claim 22 recites the means to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. In addition, the limitation "a. means for establishing a telephone connection" reads on Fig. 1, Telephone Set 111. The limitation "b. means for recording" reads on Fig. 1, Voice and Telephony Interface 114 and col. 6, lines 23-30. The limitation c. means for storing" reads on Fig. 1, Voice Web Site 102.

Claim 30 differs substantively from claim 22 in that claim 30 recites a "circuit" and "systems" to instead of "means" as in claim 22. However, the "circuit" and "systems" reads on the "means" of claim 22. Therefore, the claim 22 rejection for any further details.

Claim 37 differs substantively from claim 1 in that claim 37 recites a "server" and "systems" to perform the method steps of claim 1. Therefore, see the claim 1 rejection for any additional details. "a. a call processing and recording system..." reads on Fig. 1, Voice and

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Telephony Interface 114. "b. a server coupled to the call processing and recording system..." reads on Fig. 1, Voice Web Site 102.

Claim 48 differs substantively from claim 1 in that claim 48 recites that the file is played back to "each of one or more receiving users who access the address." This limitation reads upon Uppaluru where the message is played back to each of the one or more user who log onto the voice web system.

With respect to claim 8, see col. 1, lines 33-67.

With respect to claim 20, see col. 1, lines 33-67.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
February 4, 2004